Paper No. 29

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ICHIRO FUJIEDA and TAKESHI SAITO

Appeal No. 2001-0390
Application 08/932,238

HEARD: JANUARY 22, 2003

Before JERRY SMITH, RUGGIERO and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-6 and 43-52. Claims 7-42 stand withdrawn from consideration as being directed to a non-elected invention. Amendments after final rejection were filed on November 24, 1999 and March 8, 2000 and were entered by the examiner.

The disclosed invention pertains to an image sensor device which optically reads out a document.

Representative claim 1 is reproduced as follows:

1. An image sensor device which optically reads out a document comprising:

an image sensor portion having a plurality of light receiving elements facing a document to be read out; and

a thin film light source arranged on the document side of said image sensor portion, said thin film light source emitting light to said document,

wherein said thin film light source includes a plurality of light emission portions, each of said light emission portions emitting light to said document, and corresponding to each of said light receiving elements, said light emission portions including a light blocking layer on said light receiving elements side, and said light emmission portions being arranged between said light receiving elements and said document, at least one of said light emission portions being substantially aligned with a corresponding light receiving element.

The examiner relies on the following references:

Funada et al. (Funada) 5,101,099 Mar. 31, 1992

The admitted prior art described in appellants' specification.

Claims 1, 3, 43-46, 48-50 and 52 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Funada or the admitted prior art. Claims 2, 4-6, 47 and 51 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Funada or the admitted prior art taken alone.

Although the examiner's answer repeats the rejection of claims 1-6 and 43-52 under the second paragraph of 35 U.S.C. § 112 on page 3, the answer also indicates that this rejection has been withdrawn on page 7. Since the examiner has not responded to appellants' arguments with respect to this latter rejection, we will treat this rejection as having been withdrawn by the examiner.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports the examiner's rejections of claims 1-6 and 43-52. Accordingly, we affirm.

Even though the examiner has made separate rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103, appellants have, nevertheless, indicated that the claims should stand or fall together in three groups headed respectively by one of the independent claims. Specifically, appellants have indicated that claims 1-6 and 44-47 stand or fall together as a first group, claims 43 and 48-51 stand or fall together as a second group, and claim 52 stands or falls separately from the other claims [brief, page 7]. Since appellants have not argued each of the rejections independently, we will consider the rejections against claims 1, 43 and 52 as representative of all the claims on appeal. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Since claims 1, 43 and 52 were rejected under 35 U.S.C. § 102(e) only, we will only consider the propriety of the rejection under 35 U.S.C. § 102(e).

We consider first the rejection of representative, independent claim 1 under 35 U.S.C. § 102(e) as being anticipated by the admitted prior art. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of

performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he reads the invention of claim 1 on the admitted prior art [answer, page 5]. Appellants argue that none of the admitted prior art devices shown in Figures 1-6B have light emission portions which substantially overlap corresponding light receiving elements as claimed. Specifically, appellants argue that the light emission portions relied on by the examiner (fibers 1301, windows 1510 and opening portion 1625) are not light emission portions as defined in the claims. Appellants argue that these elements relied on by the examiner simply pass light from the document to the light receiving elements but do not emit light [brief, pages 8-11]. The examiner responds that at least one of the optical fiber array 1301 or one of the light emission portions is substantially aligned and/or overlapped with a corresponding light receiving element [answer, page 8].

We will sustain the examiner's rejection. The question comes down to whether fibers 1301, windows 1510 or opening portions 1625 of the admitted prior art constitute light emission portions within the meaning of claim 1. Appellants' argument is based on the fact that in their invention, the points where light originates are aligned with respective light receiving elements whereas, this is not true of the admitted prior art. Claim 1, however, recites a light source having a plurality of light emission portions and the light emission portions include a light blocking layer. Thus, claim 1 specifically sets forth that elements which block the passage of light are to be considered as part of the light source which includes the light emission portions. In our view, the examiner has simply applied this same definition to the admitted prior art. Specifically, the examiner has considered the light blocking and passing elements of the admitted prior art to form part of the light source as defined in claim 1. Therefore, fibers 1301, windows 1510 and opening portions 1625 are considered to form part of the light source. Since these elements determine where the light will be emitted, they are light emission portions as defined in claim 1. Since the examiner is correct that fibers 1301, windows 1510 and opening portions 1625 are substantially aligned with

corresponding light receiving elements 1306, 1502 and 1612, respectively, we agree with the examiner that claim 1 is fully met by the admitted prior art.

Therefore, the rejection of claim 1 as anticipated by the admitted prior art is sustained. Since the dependent claims have not been separately argued, they fall with independent claim 1. Although appellants have nominally argued independent claims 43 and 52 separately, the recitations of these claims and the arguments made by appellants in the brief are essentially the same as we considered above with respect to claim 1. Therefore, for the reasons discussed above, we also sustain the rejection of claims 2-6 and 43-52 as unpatentable over the admitted prior art.

We now consider the rejection of claim 1 as anticipated by the disclosure of Funada. The examiner has indicated how he reads the invention of claim 1 on the disclosure of Funada [answer, pages4-5]. Appellants argue that the light emission portions relied on by the examiner (windows 206) are not light emission portions as defined in the claims. Appellants argue that windows 206 simply pass light reflected from the document to the light receiving elements but do not emit light [brief, pages 11-12]. The examiner responds that at least one of the light incident windows of the light emitting elements in Funada is

aligned with the light incident windows of the light receiving elements [answer, pages 8-9].

We will sustain the examiner's rejection for essentially the same reasons discussed above. Specifically, the light source of Funada is considered to include light emission portions which include the light blocking elements as recited in claim 1. Since the windows 206 are, therefore, part of the light source as discussed above, we agree with the examiner that these windows emit light and are aligned with the light receiving elements 104 as claimed. Therefore, the invention of claim 1 is fully met by the disclosure of Funada. For reasons discussed above, the remaining claims on appeal fall with independent claim 1.

In summary, we have sustained the examiner's rejection of all the appealed claims based on either the admitted prior art or Funada. Therefore, the decision of the examiner rejecting claims 1-6 and 43-52 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JERRY SMITH Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

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